

REMARKS/ARGUMENT

Claims 1, 2, 6, and 7 have been amended herein and claims 10-16 have been added. Accordingly, claims 1-16 are currently pending in the present application. It is respectfully submitted that the amendments do not add new matter and have adequate support throughout the Specification.

Applicants thank the Examiner for allowing claims 4 and 5. Otherwise, Applicants respectfully traverse all claim rejections for the reasons that follow:

I. REJECTIONS OF CLAIMS 1-3 AND 6-9 UNDER 35 U.S.C. § 103(a)

Claims 1-3 and 6-9 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 3,908,735 to Di Candia (hereinafter "Di Candia"). Respectfully, Applicants traverse.

a. The rejections of claims 1-3 and 6-9 should be withdrawn because Di Candia is non-analogous art.

In order to rely on references as a basis for an obviousness rejection, the references must either be: (a) in the field of Applicants' endeavor; or (b) reasonably pertinent to the particular problem with which the invention is concerned. See In re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992); In re Deminski, 796 F.2d 436 (Fed. Cir. 1986); In re Clay, 966 F.2d 656 (Fed. Cir. 1992); M.P.E.P. § 2141.01(a).

The present invention is directed to a device for producing glass gobs. In contrast, Di Candia is related to the totally unrelated field of casting steel. Furthermore, Di Candia is not even remotely pertinent to the particular problem with which the present invention is concerned. Whereas the present invention attempts to overcome the disadvantages associated with membranes used to produce glass gobs, Di Candia is concerned with ensuring a defect-free casting of steel. (Di Candia, col. 1, lines 5-33).

For at least the foregoing reasons, Di Candia is non-analogous art as applied against the present application. As such, it is respectfully submitted that this reference may not form the basis (either in whole or in part) of obviousness rejections of claims 1-3 and 6-9.

- b. **The rejections of claims 1-3 and 6-9 should be withdrawn because there exists no motivation to modify Di Candia in the manner suggested by the Office Action**

To make out a prima facie case of obviousness of a claim, the Examiner must provide a suggestion or motivation to combine references (or modify a reference). See In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 2142. The Examiner argues that such a motivation exists – i.e., "it would have been obvious [to levitate glass gobs using the Di Candia device because] Di Canadi's device is **capable** of levitating small glass gobs as claimed." (Office Action, pages 2-3) (emphasis added). However, "[t]he mere fact that references can be . . . modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The Examiner has not provided any rationale why a person having ordinary skill in the art would be motivated to employ the Di Candia device – a device related to the casting of steel -- to levitate glass gobs.

- c. **The rejections of claims 1-3 and 6-9 should be withdrawn because Di Candia does not disclose every feature of the claimed invention**

Claim 1 relates to "[a] device for producing glass gobs, comprising . . . at least one gas channel, formed in the membrane body and larger in cross section than the pores therein and configured to introduce compressed gas into the membrane body and to pass the compressed gas across the membrane body."

Di Candia does not relate to the formation of glass gobs, but rather is directed to the totally unrelated field of casting steel. Di Candia discloses a discharger 1 and outlet ports 2 surrounded by a rigid ingot mold 3. (Di Candia, col. 2, lines 37-44). Liquid, molten steel is introduced into the mold 3 and, through the injection of an inert gas into a cavity formed within the mold, advantageous currents are produced for preventing non-metallic material from concentrating on the interface between the hardened steel and the liquid steel. (Di Candia, col. 2, lines 51-63).

It is respectfully submitted that Di Candia does not disclose " . . at least one gas channel . . . configured to introduce compressed gas into the membrane body," as recited in claim 1. As described above, Di Candia discloses outlet ports for receiving molten steel, not gas channels for receiving compressed gas.

For at least the foregoing reasons, it is respectfully submitted that claim 1 is allowable over Di Candia. Furthermore, since claims 2, 3, and 6-9 ultimately depend from claim 1, it is respectfully submitted that these claims are allowable over Di Candia for at least the same reasons. Accordingly, it is kindly requested that the rejections of claims 1-3 and 6-9 under 35 U.S.C. § 103(a) be withdrawn.

II. NEW CLAIMS 10-16

Claims 10-16 have been added herein. It is respectfully submitted that the new claims do not add new matter and have adequate support throughout the Specification. For example, claim 10 recites "[t]he device of claim 1, further comprising an arrangement operable to introduce the glass gobs to the gas outlet surface of the membrane body." This feature is clearly supported throughout the Specification, for example, on page 1, lines 7-14.

Furthermore, it is respectfully submitted that claims 10 is allowable over Di Candia at least because this reference does not disclose "an arrangement operable to introduce the glass gobs to the gas outlet surface of the membrane body." Since claims 11-16 ultimately depend from claim 10, these claims are allowable over Di Candia for at least the same reasons.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that all pending claims are currently in allowable condition. Accordingly, reconsideration and prompt allowance of all pending claims is therefore earnestly solicited.

EXPRESS MAIL CERTIFICATE

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail to Addressee (mail label #EV343721476US) in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, Alexandria, VA 22313-1450, on October 1, 2004

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